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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Stern et al.

Applicants: Randolph A. Stern and Michael N. Byles
Serial No.: 09/558,329
Confirmation No.: 9722
Filed: April 25, 2000
Examiner: Cheryl Juska
Group Art Unit: 1771
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith

Cincinnati, OH 45202

March 29, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REPLY BRIEF

I hereby certify that this correspondence is being deposited in triplicate
with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant
Commissioner for Patents, Washington, D.C. 20231 on March 29, 2002.

Keith R. Haupt
Reg. No. 37,638

March 29, 2002
Date

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TC 1700

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REPLY BRIEF

This Reply Brief under 37 C.F.R. § 1.193(b)(1) is in response to the Examiner's Answer mailed January 29, 2002 in the above-captioned appeal.

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I. Section 112 Enablement Rejection

A. Proper Test of Enablement Supports Appellant's Position

Appellant's Appeal Brief clearly, concisely and correctly reiterates that the proper test of enablement is whether one reasonably skilled in the art could make or use the invention from the specification's disclosure with information known in the art and without undue experimentation. Brief on Appeal, page 7, and cases cited therein. Moreover, the Manual of Patent Examining Procedure (MPEP) re-affirms that the correct standard for determining whether the specification meets the enablement

requirement is whether any person skilled in the art can make and use the invention without undue or unreasonable experimentation. MPEP §2164.01, citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1960); In re Wands, 858 F.2d 731,737, 8 USPQ2d 1400,1404 (Fed. Cir. 1988).

Additionally, the Examiner's Answer admits that one skilled in the art would not require undue experimentation to determine suitable felt webs for the present invention (Examiner's Answer, page 14, lines 19-22). Therefore, Appellants assert that the Section 112 rejections are baseless and that one reasonably skilled in the art could readily make and use the invention of Claims 30-87 from the disclosure of U.S. Pat. No. 5,902,757 ("the '757 patent) coupled with information known in the art without undue experimentation. United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217,1223 (Fed. Cir. 1988).

B. The Examiner Has Not Considered the Entire Disclosure of the '757 Patent

The enablement rejection of Claims 30-87 is based solely upon the Examiner's assertion that the hydrophobic/hydrophilic properties of the web are critical and since they are not cited in the rejected claims, that enablement is lacking. However, the Examiner fails to consider the entire disclosure of the '757 patent. Moreover, the Examiner focuses on the hydrophobic/hydrophilic nature of the web as being the core concept and critical element of Appellants' invention. Such emphasis on the hydrophobic/hydrophilic features is erroneous, and the '757 patent disclosure in its entirety supports Appellant's position.

Specifically, in the Description of Prior Art section of the '757 patent, Appellant's own prior product is identified under the trademark COMPLY® as "an integral web fabric that provides a hydrophobic upper surface and a hydrophillic lower surface in wicking communication with the upper surface." (Column 1, lines 30-32). As such Appellant has admitted that felt webs having both hydrophobic and hydrophillic components are known in the art prior to the invention of Claims 30-87. Therefore, how could such features be critical/essential to the invention? The answer is simply that the hydrophobic/hydrophillic properties of the felt web are not critical or essential and Appellant's invention provides other patentably important features.

Disclosure in the '757 patent, when considered in its entirety, clearly shows that the hydrophillic/hydrophobic features of the web are not critical or essential to the invention. As described in the Background of the Invention of the '757 patent, the manufacture of incontinent pads and similar products presents significant cost concerns especially due to the need to separately manufacture a facing fabric and a felt layer and to then apply a quilting process to hold those layers together. (Col. 1, lines 36-40). The focus of Appellant's invention is to provide "an improved fluid-retaining fabric such as may be substituted for the facing fabric and felt of the prior incontinent pads and which reduces the cost of manufacture thereof." (Column 1, lines 44-47) Therefore, manufacturing considerations and the provision of an appropriate facing fabric in a fluid retaining product such as an incontinent pad or the like are the critical and essential features/elements of Appellant's invention. As such, the yarn faces, which are produced by the stitch bonded yarns extending through the felt web as

presented throughout the entire disclosure of the '757 patent is the focus of Appellant's invention.

Analysis of the entire disclosure of the '757 patent and not solely the preferred embodiments or specific examples of the felt webs to which the stitch bonding is applied to produce yarn faces clearly demonstrates this fact. The Examiner's assertions and arguments to the contrary myopically focus on only specific parts of the disclosure. In support of those arguments, the Examiner has judiciously picked and extracted portions of the disclosure of the '757 patent which relate to one embodiment of a felt web which happens to include hydrophobic/hydrophilic properties. However, an analysis of the entire '757 patent as is proper under an enablement inquiry, reveals that Claims 30-87 are in fact compliant with 35 U.S.C. §112. Features which are merely preferred and are not considered critical are not required in the claims for proper enablement.

The '757 patent provides more than adequate guidance for one skilled in the art to practice the invention of Claims 30-87 without undue experimentation. Proper analysis of the patentable features of Claims 30-87 reveals that those claims are commensurate in scope with disclosure in the '757 patent. The Examiner would limit Appellant's claims to only the specific materials/features disclosed in the '757 patent. However, to require Appellants to include the hydrophobic/hydrophilic features in the claims even though such features are merely preferred, would not serve the Constitutional purpose of the patent system in promoting progress in the useful arts. In re Fuetterer, 319 F.2d 259, 265, 138 USPQ 217, 223 (CCPA 1963).

D. The '757 Patent Discloses at Least One Method for Making the Claimed Invention.

As long as a specification discloses at least one method for making and using a claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. §112 is satisfied. MPEP §2164.01(b), citing In re Fisher, 427 F 2d. 833, 839, 166 USPQ 18,24, (CCPA 1970). Clearly Appellants do provide at least one method of making an incontinent pad with stitch bonded facing fabric or fluid retaining fabric as required in Claims 30-87. Such a method just happens to include hydrophobic/hydrophillic elements. Such a method does in fact bear reasonable correlation to the entire scope of the claims in light of the fact that the hydrophobic/hydrophillic features are not critical to the patentability of the invention. An almost infinite variety of felt web materials which may or may not include hydrophobic/hydrophillic components would be easily understood by those skilled in the art applicable to this invention. Whether the '757 patent does or does not include other materials to make the invention of Claims 30-87, web materials which are readily known, does not render Claims 30-87 invalid under 35 U.S.C. §112 Spectra-Physics, Inc. v. Coherent, Inc., 827 F 2d. 1524,1533, 3 USPQ2d, 1737,1743 (Fed. Cir.) *cert. denied*, 44 US 954 (1987).

Moreover, as stated in the Appeal Brief, the technology or subject matter of Claims 30-87 is highly predictable. Persons of ordinary skill in the art readily recognize the capabilities and characteristics of felt webs, hydrophillic materials, hydrophobic materials, and related structures. See Milliken Research Corp. v. Dan River, Inc., 222 USPQ 571, 582 (Fed. Cir. 1984) ("The knowledge and skill of a skilled

knitter are of a high caliber. He is able and expected to adopt and supplement general instructions in the construction sheet for a particular fabric in its manufacture.")

Therefore, the amount of guidance or direction required in the disclosure of the '757 patent to enable the invention is low.

The amount of guidance or direction required to enable an invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. In re Fisher, 427 F. 2d. 833, 839, 166 USPQ 18, 24 (CCPA 1970). The information in the '757 patent teaches one of ordinary skill in the art readily how to manufacture an incontinent pad, a stitch bonded facing fluid retaining fabric according to Claims 30-87. A significant amount of knowledge is readily available to those skilled in the art about the nature of such inventions and how to make and use them. One skilled in the art can readily anticipate the effect of a change such as the substitution of any felt web with the felt webs disclosed in the '757 patent thereby establishing predictability in the related art. A single embodiment such as that described in the '757 patent provides broad enablement for technologies such as those involved in the claims of the present application. In re Vickers, 141 F. 2d. 522, 526-527, 61 USPQ 122, 127 (CCPA 1944); In re Cook, 439 F. 2d. 730, 734, 169 USPQ 298, 301 (CCPA 1971). Those of ordinary skill in the art would find it obvious from the disclosure of the preferred embodiment of a felt web in the '757 patent how other felt webs would work within the invention of Claims 30-87.

Therefore, since the proper test of enablement is satisfied, once the entire disclosure of the '757 patent and high level predictability and skill in this art are considered, the Section 112 rejections must be reversed.

II. Prior Art Rejections

In the Appeal Brief, as well as prior responses to rejections submitted to the Examiner, significant and substantial reasons why the §§102 and 103 rejections are improper were presented. Specifically, a common thread which substantiates the patentability of Claims 31-87 relative to the cited references is the inclusion of a "yarn face" on the top and/or bottom surface of the felt web. Detailed explanation of this novel and non-obvious feature is presented in the Appeal Brief.

The crux of the prior art rejections in this Appeal is the Examiner's improper interpretation of the term "yarn face" in the claims. The Examiner has failed to give proper patentable significance to the term "yarn face" as developed in the '757 patent disclosure. An understanding of the term "yarn face" as used in the claims is aided by recourse to the remainder of the disclosure in the '757 patent. The meaning of the term "yarn face" and its scope would be readily understood by a person experienced in this field. The claims are directed to an invention that is described in the specification. The claims and specifically the term "yarn face" do not have meaning divorced from the context from which they arose. S3, Inc. nVIDA Corp., 59 USPQ2d, 1745, 1749 (Fed. Cir. 2001).

The purpose of patent claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. A claim, and specifically a term such as "yarn face" in the claims, cannot be interpreted properly without going beyond the claim itself as is required. Autogiro Co. of America v. United States, 384 F. 2d. 391, 397, 155 USPQ 697, 701 (Ct. Cl. 1967).

As explained in the '757 patent, a "yarn face" is constructed of yarn segments that cooperate to define a face of fabric above a surface of the web. The "yarn faces" are effectively continuous¹ such that the web is not exposed. ('757 Patent, Column 2, lines 52-65).

Proper claim construction does not limit nor broaden the claims, but defines them as a matter of law as well as the invention to be patented. Claims are always construed in light of the specification of which they form a part. Netword LLC v. Centraal Corp., 58 USPQ 2d 1076, 1079 (Fed. Cir. 2001), citing Slimfold Mnfg. Co. v. Kinkead Industries, Inc., 810 F. 2d. 1113, 1118, 1 USPQ2d, 1563, 1566 (Fed. Cir. 1987). The '757 patent presents a description of the technology and subject matter of Appellants' invention while the claims point out with particularity the subject matter that is to be patented. The claims as such do not have meaning removed from the context from which they arose. The claims are directed to the invention that is described in the '757 patent. Renishaw plc v. Marposs Societa' per Azioni, 158 F. 3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("[T]he interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelope with the claim.")

As such Appellants hereby reassert that the term "yarn face" as properly interpreted includes the definition provided in the '757 patent. Moreover, such a

¹Examiner's Answer incorrectly refers to the term "essentially continuous". As such, the claims themselves are being interpreted improperly, and non-existent terms are being analyzed for such interpretation. (Examiner's Answer, page 18, lines 12 and 13).

description that the "yarn face" is formed from yarn segments that provide an effectively continuous surface is both definite and provides an appropriate standard for ascertaining the requisite degree of continuity as will be readily understood by one of ordinary skill in the art. The yarn face is comprised of yarn segments that are effectively continuous to a degree that the web is not exposed. The fact that such a definition and associated claim language is not as precise as the Examiner would prefer does not render the claim invalid under a proper application of the law. The '757 patent unambiguously provides a standard for measuring the degree of continuity (i.e., such that the web is not exposed). One of ordinary skill in the art would readily comprehend such a standard. See Exxon Research and Engineering Co. vs. United States, 60 USPQ2d 1272, 1280 (Fed. Cir. 2001); Seattle Box Co. v. Industrial Crating & Packaging, Inc., 731 F. 2d. 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The '757 patent teaches that the web should not be exposed through the yarn face to provide a soft, comfortable layer against a patient's skin. Therefore, when properly interpreted, the claims and the term yarn face have the meaning as provided for in the '757 patent.

Once interpreted in this manner, the basis for maintaining the prior art rejections with respect to each of the identified prior art references in the Examiner's Answer evaporates. Specifically, with respect to the Sternlieb, Lefkowitz, Ott and Gillies references, the Examiner's Answer states that the clear distinctions between Appellants' claimed invention and these references are unpersuasive because the claims allegedly do not require the yarn faces to be continuous (Examiner's Answer, page 19, lines 19-22; page 20, lines 6 and 7, 10 and 11, and 18-19). As such, when


the claims are properly interpreted to include the "yarn face" that is effectively continuous so that the underlying felt web is not exposed as validated in the '757 patent specification, the Examiner's basis for maintaining the prior art rejections crumbles.

III. Conclusion

For the reasons stated, Appellants respectfully urge the Board to reverse the rejections of claims 1-87.

Respectfully submitted,

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